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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/013,988	12/13/2001	Gheorghe Cosma	34090-06263	1007
25243	7590	11/19/2004		
COLLIER SHANNON SCOTT, PLLC 3050 K STREET, NW SUITE 400 WASHINGTON, DC 20007			EXAMINER SOLIS, ERICK R	
			ART UNIT	PAPER NUMBER
			3747	

DATE MAILED: 11/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/013,988

Applicant(s)

COSMA ET AL.

Examiner

Erick R Solis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2003 and 18 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

The action that follows below is supplemental to the office action previously mailed on 22 March 2004. It is the same except for that at paragraphs 6 and 7, the 35 USC 102(b) rejection has been changed to a 35 USC 102(e) rejection. Note the earliest effective filing date of the applied reference, US 5680841, is August 8, 1995.

Reissue Applications

1. This application is objected to under 37 CFR 1.172(a) as the assignee has not established its ownership interest in the patent for which reissue is being requested. An assignee must establish its ownership interest in order to support the consent to a reissue application required by 37 CFR 1.172(a). The assignee's ownership interest is established by:

(a) filing in the reissue application evidence of a chain of title from the original owner to the assignee, or

(b) specifying in the record of the reissue application where such evidence is recorded in the Office (e.g., reel and frame number, etc.).

The submission with respect to (a) and (b) to establish ownership must be signed by a party authorized to act on behalf of the assignee. See MPEP § 1410.01.

An appropriate paper satisfying the requirements of 37 CFR 3.73 must be submitted in reply to this Office action.

Specifically, the patent was assigned at the time of grant to an entity called "Diesel Engine Retarders" and therefore, it is unclear how the inventors are assigning the invention to "Jacobs Vehicle Systems., Inc." in the paper executed 19 December 1997.

2. The reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414.

The applicant does not specifically state what the changes to the claims are, applicant must describe how the new claims differ from the patented claims.

3. Claims 1-50 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

4. Claims 22-50 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35

U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Specifically, in the original patent application an amendment received on 19 May 1999 added language to independent claims 1 and 23 to overcome prior art rejections. This language included the phrase in claim 1 "wherein said braking means accomplishes at least two braking operations for the at least one exhaust valve per engine cycle during the engine braking operation, wherein said intake valve operating means delays the operation of the at least one intake valve during the engine braking operation. In claim 23 (which became patented claim 19) the language included two compression release events initiated prior to compression TDC and exhaust TDC and also delaying intake valve opening.

5. The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 22,25,26 and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Hu (US Patent 5680841). See Figs. 8, 9 and 10. Note that during a positive power mode hydraulic fluid is supplied to the hydraulic passage while the exhaust lobe of the cam contacts the rocker and that during engine braking mode hydraulic fluid supply is cutoff to the hydraulic passage while the exhaust lobe contacts the rocker arm. This reads on applicants' claims. See claims 22,23 and 34.

Response to Arguments

8. Applicant's arguments filed on 22 August 2003 have been fully considered but they are not persuasive.

a. In particular, regarding the objection to the application as failing to meet the requirements of 37 CFR 1.172(a)., applicant argues that "although the assignment recordation cover sheet lists Diesel Engine Retarders as assignee, the original assignment document executed by the present inventors accurately assigns the ownership interest to Jacobs Vehicle Systems ("Jacobs") ". This argument is not persuasive since USPTO records indicate Diesel Engine Retarders, as the current assignee. See the attached "Patent Assignment Details" sheet.

b. Regarding the rejection of claims 1-50 under 35 USC 251, as being based upon a defective reissue declaration which does not comply with 37 CFR 1.175(a)(1), applicant points to general statements made regarding why it was

necessary to file the reissue application. This argument is not persuasive, because it does not **specifically, show how the new claims differ from the patented claims. See MPEP 1414.**

c. Regarding the rejection of claims 22-50 under 35 USC 251 as being an improper recapture of surrendered subject matter, applicant argues that the analysis is a two step process, and that under step 2, it must be determined whether the broader subject matter relates to surrendered subject matter. Applicant argues that no aspect of the reissue claims 22-50, relates to surrendered subject matter. First it should be noted that the rules of analysis for determining recaptured subject matter are now a 3 step process. The first 2 steps are still the same. Regarding the 2nd step, if the reissue claims omit entirely any limitation that was added/argued during the original prosecution to overcome an art rejection. Such an omission in a reissue claim, even if it includes other limitations making the claim narrower than the patent claim in other aspects, is impermissible recapture (*Pannu vs. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001)). For at least this reason applicant's argument is not found to be persuasive.

d. Regarding the 35 USC 102(e) rejection of claims 22 and 25-27 as being anticipated by US Patent No. 5680841 to Hu, applicant makes a vague statement stating that " Hu does not disclose, teach, or suggest the subject matter claimed in the present application". Applicant has also amended claims 22 and 27 to include "venting" hydraulic fluid from the lash adjuster when in braking mode.

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The examiner contends that Hu teaches "venting" as now claimed. Therefore, this rejection has also been maintained. Furthermore, note that this rejection has been changed from a 35 USC 102(b) rejection to a 35 USC 102(e) rejection.

Conclusion

9. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erick R Solis whose telephone number is (703) 308-2651. The examiner can normally be reached on Monday-Thursday.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0861.



Erick R Solis
Primary Examiner
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